



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,599	08/25/2003	Bhavesh Mehta	50269-0558	4272

29989 7590 01/03/2005

HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,599

Applicant(s)

MEHTA ET AL.

Examiner

John L Young

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3622

THIRD NON-FINAL OFFICE ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

STATUS

2. Claims 1-20 are pending.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-20 are rejected under 35 U.S.C. §103(a) as being obvious over Donian US 2004/0003398 (1/1/2004) [US f/d: 6/26/2003] (herein referred to as "Donian").

Art Unit: 3622

As per independent claim 1, Donian (the ABSTRACT; FIG. 1; FIG. 6A; FIG. 7A; FIG. 7B; and FIG. 11C) discloses: *“A system and method for displaying digital media files with compulsory advertisement files. . . .”*

Donian (¶¶[0010]; [0052]) discloses: *“the practice of mixing licensed content with advertisements and other paid announcements in a pre-configured time sequence. . . .”*

Donian (FIG. 2) discloses a: *“NETWORK. . . .”*

Donian (FIG. 5A) discloses: *“Play Media with ‘Interspliced’ Ads. . . .”*

Donian (FIG. 5B) discloses: *“Intersplicer Control Commands” an “Intersplicer” an “Ad Manager” and an “Ad Rotator. . . .”*

Donian (FIG. 6A; and FIG. 7B) discloses: *“Build and Sequence Ad Blocks”; “Establish Ad rotator”; “Determine Required Ad Time”; “Weight Candidates By Ad Time”; and “Keep Count of Total Ad Time. . . .”*

Donian (FIG. 7A) discloses: *“Intersplicer”; “Build Initial Section Sequence”; “Adaptive Ad Selection”; “Determine Required Ad Time”; “Weight Candidates By Ad Time”; and “Keep Count of Total Ad Time. . . .”*

Donian (FIG. 10B) discloses: *“Play Queue Ads”; and “Ads Present?”*

Donian (¶[0147]) discloses: *“the same block of ads plays with a particular portion of the content. . . . If the predetermined limit is exceeded, the player/viewer rotates in new ad blocks automatically.”*

Art Unit: 3622

Donian (§[0155]) discloses: *“the ads . . . may in part reflect the specific tracks used.”*

Donian (§[0169]) discloses: *“the program selects appropriate ads to go with the media request list and prepares them for insertion into the content play/view sequence. It selects which ads, if any, are to interrupt the requested content during the course of play, and then it localizes them. It groups the content into play sections, and it groups individual ads into blocks for insertion into the content. It also determines the rules and parameters by which step 518 adaptively selects and groups ads extemporaneously in response to user actions during playback, and provides an ongoing maintenance service to rotate ads into and out of play as needed during the course of the session. Given the nature of its operation, step 514, and the logic it comprises, is referred to herein as the ‘ad manager’.”*

Donian (§[0170]) discloses: *“Adhering to the selections of ad manager 514, the program sets up a play sequence of individual content segments interspoliced with blocks of ads, and it coordinates the real-time conveyance of the interspoliced content/ad play sequence to the user in real-time, by way of the system’s video display 206, 222 (FIG. 2) and audio output 208, 224 (FIG.2) hardware. Given the nature of its operation, step 514, and the logic it comprises, is referred to herein as the ‘intersplicer’.”*

Donian (§§[0173]; and [0218]) discloses: *“ad selection criteria. . . .”*

Art Unit: 3622

Donian (§[0180]) discloses: *“local database interface 562 . . . serves as the program’s store of user information and preferences, which may include without limitation, local media locations and registration data, content and advertisement viewing history . . . availability and locations of local ads, and other system maintenance data.”*

Donian (§[0202]) discloses: *“Ad manager 514 . . . establishes a concurrent ad rotator 516. The ad manager may start a new thread for this purpose, or it may communicate with maintenance . . . to assign it a new or already-existing ad rotator thread. . . .”*

Donian (§[0203]) discloses: *“Ad rotator . . . handles requests for new ads from an intersplicer . . . by selecting and localizing appropriate ads, grouping them into blocks if so requested, and sending the result back to requesting intersplicer 518. The ad rotator . . . is equipped to handle requests to replace individual ads, entire ad blocks, or the entire set of ads and blocks associated with intersplicer 518. . . . it may use the logic of the media transfer component. . . . Ad rotator . . . may also need to consult medial catalog . . . to locate new ads, but this step is typically avoided through the ad manager . . . which pre-locates alternative ads and passes this information along to ad rotator. . . . [which] synchronizes the final media request list with local database 562.”*

The Examiner interprets this disclosure as showing “determining a subset of said plurality of advertisements which qualify for inclusion in said slot. . . .”

Art Unit: 3622

Donian (§§[0204]; [0205]; [0206]) discloses: *“sequence table indicating how content is to be interspliced with ads, and . . . The intersplicer. . . selects and re-sequences ads extemporaneously in response to the user’s . . . navigational choices. . . .”*

Donian (§[0214]) discloses: *“The ability of the player/viewer software to adaptively select, sequence, and re-sequence ads that are shown on the basis of user navigation through a self-selected series of media content is a novel feature for media players. . . .”*

Donian (§§[0010]; [0043]; [0052]; [0155]; [0143]; [0147]; [0148]; [0155]; [0169]; [0170]; [0173]; [0180] [0202]; [0203]; [0204]; [0205]; [0206]; [0269]; [0214]; [0218]; the ABSTRACT; FIG. 1; **FIG. 2**; **FIG. 5A**; **FIG. 5B**; FIG. 6A; FIG. 7A; FIG. 7B; and **FIG. 10B**; FIG. 11C; and the whole document) implicitly shows “A method for determining which advertisements to include with electronic content delivered to users over a network, the method comprising the steps of: storing sequence information that indicates a sequence for a plurality of advertisements . . . receiving a request to provide over said network a piece of electronic content that includes a slot for an advertisement; comparing slot attributes of said slot with deliver criteria of said advertisements to determine a subset of said plurality of advertisements which qualify for inclusion in said slot; and from said subset of advertisements, selecting an advertisement to include in the slot based, at least in part, on relative positions, within said sequence, of the

Art Unit: 3622

advertisements in said subset.”

Donian lacks explicit recitation of the “wherein each of said plurality of advertisements is associated with corresponding delivery criteria” element of claim 1. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Donian (§§[0173]; and [0218] which discloses: “*ad selection criteria. . .*”; and the whole document) implicitly shows the “wherein each of said plurality of advertisements is associated with corresponding delivery criteria” element of claim 1; and it would have been obvious to modify and interpret the disclosure of Donian cited above as implicitly showing the “wherein each of said plurality of advertisements is associated with corresponding delivery criteria” element of claim 1 because modification and interpretation of the cited disclosure of Donian would have provided “*a revenue generating market for the . . . redistribution of media content, sponsored through paid advertising. . .*” (see Donian (§[0049])) based on the motivation to modify Donian so as to provide “*a new se of the traditional broadcasting business model . . . by adding value to freely exchanged copies of media, distributed over a digital network.*” (See Donian (§[0061])).

CLAIM REJECTIONS — 35 U.S.C. §103(a)

4. Rejections Maintained for claims 2-20.

Art Unit: 3622

As per dependent claims 2-20, Donian shows the method of claim 1 and subsequent base claims depending from claim 1.

Donian (¶¶[0010]; [0043]; [0052]; [0155]; [0143]; [0147]; [0148]; [0269]; the ABSTRACT; FIG. 1; FIG. 6A; FIG. 7A; FIG. 7B; and FIG. 11C; and the whole document) implicitly shows all of the elements of claims 2-20.

Donian lacks explicit recitation of some of the elements and limitations of claims 2-20, even though the disclosure of Donian cited above implicitly shows same.

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations of claims 2-20 were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Donian (¶¶[0010]; [0043]; [0052]; [0155]; [0143]; [0147]; [0148]; [0269]; the ABSTRACT; FIG. 1; FIG. 6A; FIG. 7A; FIG. 7B; and FIG. 11C; and the whole document) implicitly shows all of the elements and limitations of claims 2-20; and it would have been obvious to modify and interpret the disclosure of Donian cited above as showing all of the elements and limitations of claims 2-20 because modification and interpretation of the cited disclosure of Donian would have provided "*a revenue generating market for the . . . redistribution of media content, sponsored through paid*

Art Unit: 3622

advertising. . . .” (see Donian (§[0049])) based on the motivation to modify Donian so as to provide “a new se of the traditional broadcasting business model . . . by adding value to freely exchanged copies of media, distributed over a digital network.” (See Donian (§[0061])).

RESPONSE TO ARGUMENTS

5. Applicant's arguments (filed 10/12/2004) have been considered but are not persuasive for the following reasons:

Applicant's arguments are moot based on new grounds of argument for claim 1 presented in this Office action, necessitated by Applicant's amendment/comments.

As per claims 2-20, the obviousness rejections are maintained because Applicant's response failed to seasonably challenge the Official Notice evidence presented in the obviousness rejections of the prior Office Action, it is well settled in the law that “If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, Applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made.” (See MPEP 2144.03).

Art Unit: 3622

In this case, Applicant's response is silent as to a demand for references concerning the Officially Noticed well known statement evidence presented in the prior Office Action; therefore, said Official Notice evidence is deemed admitted, and no further references are required in support of said Official Notice evidence.

CONCLUSION

6. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30

Serial Number: 10/648,599

(Mehta et al.)

11

Art Unit: 3622

A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESC.
PRIMARY EXAMINER

December 27, 2004